

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of: Nancy C. Frye  
Serial No.: 10/790,923  
Filing Date: March 1, 2004  
Confirmation No.: 1435  
Group Art Unit: 3765  
Examiner: Marie D. Paterson  
Title: SHOE AND LAST

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Dear Sir:

REQUEST FOR PRE-APPEAL BRIEF REVIEW

In response to the Final Action issued October 6, 2011, Applicant respectfully requests a Pre-Appeal Brief review of this Application so that the rejection of the claims and the objections to the Application can be reconsidered prior to submission of an Appeal Brief.

REMARKS

This Request for Pre-Appeal Brief Review is being filed in accordance with the provisions set forth in the Official Gazette Notices of July 12, 2005 and January 10, 2006. Pursuant to the Official Gazette Notices, this Request for Pre-Appeal Brief Review is being filed concurrently with a Notice of Appeal. Applicant respectfully requests reconsideration of the Application in light of the remarks set forth below.

The drawings stand objected to under 37 C.F.R. §1.83(a) as not showing every feature of the invention specified by the claims. The feature of a midsole in Claims 16 and 21-24 and the substantially halfway point 824 were not properly shown in the drawings. The drawings submitted to address these objection were not entered due to a new matter objection. Claims 1, 5-7, 11, 15, 16, 19, and 21-24 stand objected under 35 U.S.C. §112, first paragraph, as failing to comply with the enablement requirement due to the issue of the midsole and the substantially halfway point 824. The claims are otherwise in an allowable condition. In the prosecution of the present Application, the Examiner's objections, rejections, and assertions contain clear errors of law. To assist the Panel in the review of this Request for Pre-Appeal Brief Review, Applicant submits the following brief summary for consideration.

In the Final Action of October 6, 2011, the Examiner indicated that the drawings are objected to for not including a midsole as specified in the claims. Applicant's specification discloses a midsole that is also a feature of Claims 16 and 21-24. A replacement drawing sheet showing an amendment to FIGURE 14 to include a midsole 829 was submitted as requested by the Examiner. The Examiner objected to the midsole in the replacement drawing sheet as the thickness, shape, and exact location was considered to be new matter.

Applicant's specification discloses the thickness, shape, and exact location for a midsole at page 22, lines 7-12, and page 29, lines 11-13. In particular, the specification states that the midsole provides cushioning, the shape of the midsole includes substantially planar surfaces, and the exact location of the midsole is between the insole and the outsole. Thus, the replacement drawing sheet requested by the Examiner does no more than show a midsole well known to those of skill in the art separating an insole from an outsole as expressly disclosed in Applicant's specification. The Examiner has improperly denied entry of the replacement drawing sheet on the grounds of new matter despite the more than ample support for the matter in Applicant's specification. As a result, no new matter has been added to the drawings that is beyond the disclosure of Applicant's specification. Therefore, Applicant respectfully submits that the replacement drawing sheet does not contain new matter and is in compliance with 37 C.F.R. §1.83(a).

The drawings stand objected to for being inconsistent with Applicant's specification. Applicant's specification discloses that a point 824 is approximately halfway across a length of shoe 810 that is also a feature of Independent Claims 1, 11, and 16. A replacement drawing sheet showing an amendment to FIGURE 14 to provide for point 824 being substantially halfway across a length of the shoe was submitted as requested by the Examiner. The location of point 824 is disclosed at page 29, lines 16-20, of Applicant's specification. Despite this express description of the location of point 824 being substantially halfway across a length of the shoe, the Examiner stated that the specification does not provide any basis for changing the location of point 824 to the specified location. The Examiner provides no reasoning for objecting to changing the location of point 824 to its described location. Moreover, in the Decision on

Appeal of March 1, 2010, the Board stated that the Examiner was amenable to the change of location of point 824. Therefore, Applicant respectfully submits that the replacement drawing sheet is in compliance with 37 C.F.R. §1.83(a).

Claims 1, 5-9, 11, 14-16, and 19-24 stand rejected under 35 U.S.C. §112, first paragraph, for failing to comply with the enablement requirement. One of ordinary skill in the art would clearly recognize from Applicant's specification that the exact location of the midsole is between the insole and the outsole and the midsole has cushioning and a shape with planar surfaces to define its thickness to allow the negative heel configuration to be provided by the insole in accordance with the claimed invention. Moreover, the specification clearly describes the location of the point where the constantly thick forward toe section of the insole meets the decreasingly thick heel section as being substantially halfway across the shoe. As a result, everything provided in the claims is described in and enabled by Applicant's specification.

The basis for this rejection is the apparent inconsistency between the specification and the drawings. The claims have not been rejected for adding new matter. A proper replacement drawing sheet with amendments to FIGURE 14 has been submitted to clear up any apparent consistencies with Applicant's specification by showing a midsole and point 824 substantially halfway across a length of the shoe. Applicant's attempt to address any inconsistency between the specification and drawings through minor changes to the drawings, changes expressly described in Applicant's specification, have been rebuffed for adding new matter. However, no justification has been provided for the Examiner's conclusion of new matter. The two minor changes to the drawings, the depiction of a basic midsole and the location of point 824, are expressly provided for in Applicant's

specification. Despite any inconsistencies, one of skill in the art would be able to easily make or use the invention provided in the claims from the subject matter described in Applicant's specification. Therefore, Applicant respectfully submits that Claims 1, 5-9, 11, 14-16, and 19-24 are in compliance with 35 U.S.C. §112, first paragraph.

These matters were raised on a previous appeal to the Board of Patent Appeals and Interferences. In the Decision on Appeal, the Board stated therein it would not take up the Examiner's objections to the drawings and refusal to enter an amendment as this is reviewable by petition. Applicant petitioned for entry of the replacement drawing sheet. The two petitions were dismissed and denied as being appropriate for consideration on appeal to the Board of Patent Appeals and Interferences due to the claim rejections under 35 U.S.C. §112, first paragraph. Thus, it appears that this Application is ripe for appeal.

CONCLUSION

Applicant has now made an earnest attempt to place this Application in condition for allowance. For the foregoing reasons and for other apparent reasons, Applicant respectfully requests allowance of all pending claims.

The Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of BAKER BOTTS L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.

Attorneys for Applicant

A handwritten signature in black ink, appearing to read "Charles S. Fish", is written over the printed name.

Charles S. Fish

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March 6, 2012

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